REMARKS/ARGUMENTS

This Request for Reconsideration is submitted in response to the Final Office

Action dated July 12, 2006, and within the TWO-MONTH period extending from the

mailing date of the Final Office Action to September 12, 2006. Please enter the following

5   ·remarks. The current status of the claims is summarized below.

Claims 13 and 18 were previously cancelled.

Claims 1-12, 14-17, and 19-20 are pending in the application.

Rejections under 35 U.S.C. § 103

10   Claims 1-12, 14-17, and 19-21 were rejected under 35 U.S.C. 103(a) as being

unpatentable over Mason (U.S. Patent No. 6,826,716) in view of Davis (U.S. Patent

Application Publication No. US2005/0198042A1) in view of Washburn et al.

("Washburn" hereafter) (U.S. Patent No. 5,157,779). These rejections are traversed.

Claim 1 recites a method for creating a test summary report. Specifically, claim 1

15   recites an operation for generating test results in an Extensible Markup Language (XML)

enabled format that is independent of an XML format capability of the platform.

In applying the combination of Mason, Davis, and Washburn (referred to as "the

reference combination" hereafter), the Office has relied upon Mason to teach generating

test results in an Extensible Markup Language (XML) enabled format. Specifically, the

20   Office has referred to Mason's teachings at (column 15, lines 25-35) and (column 2, lines

10-20).

Mason (column 15, lines 25-35) teaches that a test generator operating in the J2EE

environment is capable of having detailed knowledge of the server side quality of service

(QoS) attributes expected of the enterprise application. Moreover, Mason teaches that the

25   test generator obtains this detailed knowledge of the expected server side QoS attributes

by analyzing the XML deployment descriptors associated with deployment of the enterprise application. Mason (column 2, lines 3-6) teaches that the deployment descriptors are text files that specify component behavior in terms of well-defined XML tags. Thus, through the deployment descriptors, attributes of a component such as the

5   enterprise application can be configured at the time of its deployment to comply with specific environmental requirements.

Mason (column 2, lines 10-20) simply defines quality of service as application behaviors or XML tags related to the security or transactional control aspects of an enterprise application. Mason (column 2, lines 10-20) also defines an XML parser as a

10   software tool capable of reading an XML document and breaking down the XML elements into usable parts.

Mason's teachings (column 15, lines 25-35) are related to the test generator's ability to generate tests that are explicitly related to the server side QoS attributes expected of the enterprise application for which tests are being generated by the test

15   generator. Specifically, Mason teaches that the XML deployment descriptors associated with deployment of the enterprise application are to be analyzed by the test generator to determine which attributes are exercised by the XML deployment descriptors when the enterprise application is deployed. Then, Mason teaches that with the knowledge gleaned from the analysis of the XML deployment descriptors, the test generator is able to

20   generate test that are specifically related to the particular attributes referenced within the XML deployment descriptors, thus tailoring the generated tests to the particular attributes of the enterprise application under test. Thus, in contrast to the Office's assertions, the teachings of Mason as discussed above have nothing to do with generating test results in a particular format. In particular with regard to claim 1, the teachings of Mason have

25   nothing to do with generating test results in an XML enabled format.

Additionally, claim 1 requires that the XML enabled format in which the test results are generated be independent of an XML format capability of the platform. The Office has not cited a teaching in Mason regarding the generation of the test results in the XML enabled format, wherein the XML enabled format is independent of the XML

5   format capability of the platform. In discussion the teachings of Davis, the Office has mentioned the feature of claim 1 regarding the XML enabled format of the generated test results being independent of the XML format capability of the platform. However, the Office has failed to clearly communicate how Davis is interpreted to teach the XML enabled format of the generated test results being independent of the XML format

10   capability of the platform, as required by claim 1. Furthermore, the Office has failed to provide a reasoned explanation as to how the disclosure of Davis is thought to be combinable with the disclosure of Mason to teach the feature of claim 1 requiring the generation of test results in the XML enabled format, wherein the XML enabled format is independent of an XML format capability of the platform.

15   In view of the foregoing, the teachings of Mason, particularly those provided at (column 15, lines 25-35) and (column 2, lines 10-20), have nothing to do with performing the operation of generating test results in an XML enabled format that is independent of an XML format capability of the platform, as recited in claim 1. Moreover, the cited teachings of Mason have no relevance whatsoever to a format of test results, much less

20   the XML enabled format that is independent of an XML format capability of the platform, as recited in claim 1.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the

25   patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165

USPQ 494, 496 (CCPA 1970). Based at least on the foregoing discussion of how the disclosure of Mason fails to teach the features of claim 1 as asserted by the Office, the Applicant submits that all the limitations of claim 1 are not taught or suggested by the prior art. Therefore, the Applicant requests that the Office withdraw the outstanding

5   rejection of claim 1 under 35 U.S.C. 103. The Applicant provides additional reasons below as to why claim 1 is not rendered prima facie obvious by the reference combination.

Claim 1 further recites an operation for using the XML enabled test results to create a test summary report. The Office has cited Davis as teaching the operation for

10   using the XML enabled test results to create a test summary report. Davis teaches a method for providing a "chart view" for a markup language. The chart view of Davis includes the components necessary for automatically manipulating and graphically displaying numerical data contained in a reusable data markup language (RDML), wherein RDML is a markup language such as HTML or XML. The chart view of Davis

15   transforms, formats, manipulates, and displays data stored in the RDML markup documents using attributes that describe the meaning of the data. The Office essentially asserts that the chart view method of Davis teaches a mechanism by which data in an XML document can be transformed, formatted, manipulated, and displayed based on attributes associated with the data in the XML document. The Office further asserts that

20   the chart view method of Davis is capable of being used to perform the operation of claim 1 regarding using the XML enabled test results to create a test summary report.

While the chart view of Davis may be considered to have the CAPABILITY of using XML based test results to create a test summary report, Davis does not actually teach an operation for USING XML based test results to create a test summary report. As

25   a matter of fact, Davis is silent with regard to XML based test results and the creation of a

test summary report using XML based test results. Thus, it is only possible through the use of hindsight afforded by the disclosure of the present invention to construe Davis as teaching the claimed feature of using XML based test results to create a test summary report.

5   Per MPEP 2142, impermissible hindsight must be avoided when considering whether a claim is prima facie obvious under 35 U.S.C. 103, and the legal conclusion must be reached on the basis of the facts gleaned from the prior art, not from the Applicant's disclosure. Because Davis, and both Mason and Washburn for that matter, is silent with regard to XML based test results and a test summary report created therefrom, 10   the Applicant submits that the Office's assertions regarding the teachings of Davis are based on the Applicant's disclosure rather than facts gleaned from the prior art.

Claim 1 further recites that the XML enabled test results include test suite tags, wherein each test suite tag encapsulates the test results corresponding to each test suite of the computer software test application. In applying the reference combination, the Office 15   has relied upon Washburn to teach the test suite tags included within the XML enabled test results. Washburn, however, is silent with regard to XML and more particular with regard to XML enabled test results. Also, as discussed above Mason does not teach XML enabled test results either. Therefore, the Applicant reiterates that the reference combination does not teach XML enabled test results. Additionally, because the invention 20   of Washburn is believed to predate the advent of XML, the Applicant submits that it is not reasonable for the Office to even attempt to construe Washburn as teaching a type of XML tag, much less the test suite tag included in the XML enabled test results and recited in claim 1. As the reference combination fails to teach the test suite tag of claim 1, it follows that the reference combination also fails to teach the test suite tag property of

encapsulating the test results corresponding to each test suite of the computer software test application.

Again, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180

5   USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Because the reference combination fails to teach the test suite tags included within the XML enabled test results, the Applicant submits that all the limitations of claim 1 are not taught or suggested by the prior art. Therefore, the

10   Applicant again requests that the Office withdraw the outstanding rejection of claim 1 under 35 U.S.C. 103.

Notwithstanding the fact that the reference combination fails to teach each and every feature of claim 1, the Applicant submits that there is no motivation or suggestion within the Mason, Davis, and Washburn references to have combined their teachings in

15   the manner suggested by the Office. Specifically, as discussed above, Mason is not concerned with (and does not teach) generating test results in an XML enabled format. Also, as discussed above, Davis is not concerned with (and does not teach) generating test results in an XML enabled format and using the XML enabled test results to create a test summary report. Furthermore, Washburn is not concerned with (and does not teach)

20   anything related to XML, much less generating test results in an XML enabled format. Therefore, the Applicant submits that the Office has effectively and inappropriately used the Applicant's disclosure as a blueprint for piecing together unrelated teachings of the cited art of record in an attempt to establish a prima facie case of obviousness against claim 1. Simply stated the motivation and/or suggestion to combine the Mason, Davis,

and Washburn references in the particular manner suggested by the Office is not found within the references themselves.

As should be understood by the Office, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

5   prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Also, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior

10   art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

With regard to independent claims 11, 16, and 21, the Office has applied the same basis of rejection for subject matter similar to that recited in claim 1. Therefore, the Applicant's arguments presented above with regard to claim 1 are equally applicable to

15   similar subject matter recited in each of claims 11, 16, and 21. Also, because each of dependent claims 2-10, 12, 14-15, 17, and 19-20, incorporates all features of its respective independent claim, each dependent claim is patentable for at least the same reasons provided for its respective independent claim. Therefore, the Office is kindly requested to withdraw the rejections of claims 1-12, 14-17, and 19-20, under 35 U.S.C.

20   103.

The Applicant submits that all of the pending claims are in condition for allowance. Therefore, a Notice of Allowance is requested. If the Examiner has any questions concerning the present Request for Reconsideration, the Examiner is requested to contact the undersigned at (408) 774-6914. If any additional fees are due in connection

5   with filing this Request for Reconsideration, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP024). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,

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